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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
2143	1

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,967

Applicant(s)

SERENA, FRANK DAVID

Examiner

George C Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 35-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 35-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-12, 14-23 and 35-51 have been reexamined. Claim 13 has been cancelled.

Response to Arguments

2. Applicant's arguments filed 8 December 2003 have been fully considered but they are not persuasive.

In regards to Applicant's argument that Kurtzman does not teach or disclose the claimed subject matter, the Examiner traverses these arguments. Kurtzman expressly discloses:

"The client 175 is representative of a computer used to access the Internet 170. The client 175 is executing the browser program 177. In other embodiments, other techniques for accessing the Internet 170 can be used, such as an integrated browsing and operating system, such as Windows 98. The browser 177 is responsible for displaying a page 179. The page is a dynamically generated display of information. The page 179 includes advertisement 174 and advertisement 172 that were retrieved from the ad server 100. The page 179 corresponds to, for example, an HTML (Hypertext Mark Up Language) page. The Internet 170 represents any form of communications network that would support computer communications." (column 5, lines 38-50)

"The content stream engine 116 analyzes the content of the page 179 and attempts to match a corresponding advertisement reflecting the interests of the user. One embodiment of such a content stream engine 116 is described in United States

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patent application entitled, "Content Stream Analysis," filed Apr. 24, 1997, having Ser. No. 08/847,778, and inventor Stephen J. Kurtzman, II, incorporated herein by reference. " (column 4, lines 50-57)

Clearly, Kurtzman does in fact disclose the claimed subject matter within these disclosures that further distinguish the references made in the previous Office Action. The Applicant is also invited to consider US Patent 6 044 376 A cited in the previous Office Action and incorporated by reference within Kurtzman as shown above.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12, 14-15, 17-23 and 35-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurtzmann, II [US Patent 6 044 376 A].

Regarding claim 1, Kurtzmann discloses a computer-implemented method of controlling content, the method comprising: receiving input from a user; monitoring content in a processing environment to be accessed by the user; determining whether monitored content includes a predetermined advertisement; and if the monitored content includes the predetermined advertisement, replacing the predetermined advertisement with another predetermined advertisement based on the user input.

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[column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 2, Kurtzmann discloses the method of claim 1, wherein receiving input from the user comprises receiving information about content that the user wishes to control. [column 2, lines 9-12; column 3, lines 21-31 and 44-50; column 3, line 58-column 4, line 8]

Regarding claim 3, Kurtzmann discloses the method of claim 2, further comprising generating the other predetermined advertisement based on the received user information. [column 3, line 58-column 4, line 8]

Regarding claim 4, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring content in a database manager, a spreadsheet, a communications package, a graphics program, a word processor, or a network browser. [column 2, lines 19-29; column 3, lines 33-67]

Regarding claim 5, Kurtzmann discloses the method of claim 1, wherein receiving input from the user comprises receiving information from an organization designated by the user. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 6, Kurtzmann discloses the method of claim 5, further comprising generating the other predetermined advertisement based on received organization information. [column 2, line 66-column 3, line 2; column 3, line 58-column 4, line 18]

Regarding claim 7, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring text, video, audio, image, animation, or

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document link in the application program. [column 2, line 52-column 3, line 32; column 4, lines 20-25]

Regarding claim 8, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring information related to the originator of content. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 9, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring content exchanged between a network browser and a network server. [column 3, lines 32-67]

Regarding claim 10, Kurtzmann discloses the method of claim 1, further comprising activating rules including generating rules using the received user input and updating rules using the received user input and the generated rules. [column 2, line 63-column 3, line 32; column 4, lines 1-19]

Regarding claim 11, Kurtzmann discloses the method of claim 10, wherein determining whether monitored content includes a predetermined advertisement comprises: extracting an identifier from the content; and using the rules comparing the extracted identifier with a predetermined set of identifiers that correspond to a predetermined set of advertisements. [column 2, line 52-column 3, line 50; column 4, lines 1-25]

Regarding claim 12, Kurtzmann discloses the method of claim 11, wherein if the extracted identifier matches one of the predetermined sets of identifiers, replacing the corresponding predetermined advertisement with the other predetermined

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advertisement. [column 2, line 52-column 3, line 67, specifically column 3, lines 58-67; column 4, lines 1-25]

Regarding claim 14, Kurtzmann discloses the method of claim 1, wherein replacing the predetermined advertisement with another predetermined advertisement comprises replacing the predetermined advertisement with text, video, audio, image, animation, or a link to a document. [column 2, line 52-column 3, line 50, specifically column 3, lines 58-67; column 4, lines 1-25]

Regarding claim 15, Kurtzmann discloses the method of claim 1, wherein replacing the predetermined advertisement with another predetermined advertisement comprises accessing the other predetermined advertisement from a user's computer or from a network server. [column 2, line 52-column 3, line 50, specifically column 2, lines 57-62; column 4, lines 1-25]

Regarding claim 17, Kurtzmann discloses the method of claim 1, wherein monitoring occurs at a network server separate from the user's computer. [column 2, line 52-column 3, line 67]

Regarding claim 18, Kurtzmann discloses software in a computer-readable medium comprising instructions for causing a computer system to perform the following operations: receive input from a user of a computer system; monitor content in a processing environment to be accessed by the user; determine whether monitored content includes a predetermined advertisement; and if the monitored content includes the predetermined advertisement, replace the predetermined advertisement with another predetermined advertisement based on the user's input. [column 1, line 55-

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column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 19, Kurtzmann discloses a computer system for controlling content, the system comprising a client computer programmed to receive input from a user and to operate an application program in a processing environment; and a second computer interconnected with the client computer by an internetwork and programmed to: observe content in the a processing environment to be accessed by the user, determine whether observed content includes a predetermined advertisement, and if the observed content includes the predetermined advertisement, replace the predetermined advertisement with a predetermined identifier that corresponds to another predetermined advertisement based on the user input. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 20, Kurtzmann discloses the computer system of claim 19, further comprising a second set of instructions for programming the second computer to: receive the predetermined identifier; and replace the predetermined identifier with the corresponding other predetermined advertisement. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50, specifically column 3, lines 32-67; column 3, line 58-column 4, line 25]

Regarding claim 21, Kurtzmann discloses a computer-implemented method of controlling content in a processing environment to be accessed by the user, the method comprising: receiving an input from the user; observing content in the processing environment to be accessed by the user; determining whether observed content

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includes predetermined advertisement content would direct the user to a predetermined advertisement; and if the observed content includes predetermined advertisement content that would direct the user to the predetermined advertisement, replacing the observed content with other content that directs the user to another predetermined advertisement based on the user input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 22, Kurtzmann discloses software in a computer-readable medium comprising instructions for causing a computer system to perform the following operations: receive input from a user of a computer system; monitor content in a processing environment to be accessed by the user; determine whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and if the monitored content includes predetermined advertisement content that would direct the user to the predetermined advertisement, replace the monitored content with other content based on the user's input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 23, Kurtzmann discloses a computer system for controlling content, the system comprising: a client computer programmed to receive input from a user and to operate an application program; a second computer interconnected with the client computer by an internetwork and programmed to: observe content in a processing environment to be accessed by the user, determine whether observed content would

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direct the user to a predetermined advertisement, and if the observed content would direct the user to the predetermined advertisement, replace the observed content with other content based on the user input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 35, Kurtzmann discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising: receiving input from a user; monitoring content in the processing environment to be accessed by the user; determining whether monitored content includes a predetermined advertisement; if the monitored content includes the predetermined advertisement, selecting a selected advertisement, based on the user input, for incorporation into the content; and causing the content to be accessed by the user with the selected advertisement incorporated therein. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 36, Kurtzmann discloses the method of claim 35 wherein the predetermined advertisement is one of a plurality of advertisements from which the selected advertisement is selected. [column 2, lines 57-62]

Regarding claim 37, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user is content to be viewed by the user. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

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Regarding claim 38, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises text. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 39, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises video. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 40, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises sounds. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 41, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises images. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 42, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises movies. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 43, Kurtzmann discloses the method of claim 35 wherein the processing environment through which the content is accessed by the user comprises a television tuner for receiving television signals that carry the content. [column 2, lines 19-29; column 5, line 62-column 6, line 2]

Regarding claim 44, Kurtzmann discloses the method of claim 35 wherein the processing environment is a computer application program or a communication channel

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between an operating system residing at a users computer system and the computer application program. [column 3, lines 33-67]

Regarding claim 45, Kurtzmann discloses the method of claim 35 wherein monitoring content comprises monitoring information related to the originator of content. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 46, Kurtzmann discloses the method of claim 35, wherein the step of receiving input from a user comprises receiving directly from the user information about content that the user wishes to control. [column 2, lines 9-12; column 3, lines 21-31 and 44-50; column 3, line 58-column 4, line 8]

Regarding claim 47, Kurtzmann discloses the method of claim 35, wherein the step of receiving input from a user comprises observing information relating to the user and generating content preferences based on these observations. [column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 48, Kurtzmann discloses software in a readable medium comprising instructions for causing a processor to perform the following operations in a processing environment in which content may be accessed: receive input from a user; monitor content in the processing environment to be accessed by the user; determine whether monitored content includes a predetermined advertisement; if the monitored content includes the predetermined advertisement, select a selected advertisement, based on the user input, for incorporation into the content; and cause the content to be accessed by the user with the selected advertisement incorporated therein. [column 1,

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lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50;
column 3, line 58-column 4, line 25]

Regarding claim 49, Kurtzmann discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising: receiving input from the user; monitor content in the processing environment to be accessed by the user; determining whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and if the monitored content includes predetermined advertisement content that would direct the user to the predetermined advertisement, selecting selected content, based on the user input, and causing the user to be directed to the selected content. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 50, Kurtzmann discloses the method of claim 49 wherein the predetermined advertisement is one of a plurality of items of content from which the selected content is selected. [column 2, lines 57-62]

Regarding claim 51, Kurtzmann discloses software in a readable medium comprising instructions for causing a processor to perform the following operations in a processing environment in which content may be accessed: receive input from a user; monitor content in the processing environment to be accessed by the user; determine whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and the monitored content includes predetermined advertisement content that would direct the user to the predetermined

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advertisement, selecting selected content, based on the user input, and causing the user to be directed to the selected content. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtzmann.

Regarding claim 16, Kurtzmann discloses the method of claim 1.

Kurtzmann does not expressly disclose wherein monitoring occurs at the user's computer system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurtzmann to have monitoring done on a client machine.

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The Examiner takes Official Notice that the concept of executing operations on a client machine that are normally done on a server in order to distribute the processing burden normally placed on the server is well known and used in the art. Therefore, one of ordinary skill in the art would have applied this concept to modify Kurtzmann to achieve the invention as claimed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Tuesday 1-2 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn



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